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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,797	09/16/2003	Lisa H. Neuberger	12587-038001 / 01476-00/U	3489
26161 7590 02/28/2008 FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER MANSFIELD, THOMAS L	
			ART UNIT 3623	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/664,797	<b>Applicant(s)</b> NEUBERGER ET AL.	
	<b>Examiner</b> THOMAS MANSFIELD	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the Application filed on 16 September 2003.
2. Claims 1-52 are currently pending and have been examined.

### ***Drawings***

3. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the drawings contain hand-drawn numbering and illustrations. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Claim Objections***

4. Claim 46 is objected to because of the following informalities: Claim 46 recites, "*The method of Claim 4...*". Claim 46 should state, "*The method of Claim 43...*". Appropriate correction is required. For examination purposes, the Examiner will interpret Claim 46 as depending from claim 43.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mechling et al (Mechling), "Defining and Measuring Success In Canadian Public Sector Electronic Service Directory", Issue Paper Prepared for Discussion and Debate at Lac Carling V, April 24, 2001, in view of Spears et al (Spears), "Citizens First 2000", Public Sector Service Delivery Council and The Institute of Public Administration of Canada, 2001), and in further view of Official Action.

7. **CLAIM 35:**

With regard to Claim 35, Mechling teaches:

- *identify at least one outcome measure* (outputs and outcomes) (see at least page 21, paragraph 4) *and at least one cost-effectiveness measure* (people are often the most cost-effective measuring instruments) (see at least page 27, paragraph 1) *for a public sector organization* (Using targets or milestones as drivers for change in the public sector's pursuit of ESD [Electronic Service Delivery]) (see at least page 10, paragraph 1).
- *Obtain measurements associated with measures* (measurements taken independently can be aggregated into more comprehensive measures) (see at least page 38, paragraph 6).

- *determine a relative performance measure of the public sector organization based on the measurements (Level of Measurement) (see at least page 22, Results Category scorecard).*

**8. CLAIM 36:**

With regard to Claim 36, Mechling teaches *wherein obtaining measurements includes obtaining measurements from public data sources (data collection instruments, individual citizens) (see at least page 35, paragraph 1).*

**9. CLAIM 37:**

With regard to Claim 37, Mechling teaches *wherein obtaining measurements from public data sources includes obtaining background information from the organization (performance of the same organization at an earlier period of time) (see at least page 35, paragraph 3).*

**10. CLAIM 38:**

With regard to Claim 38, Mechling teaches *comparing the relative public performance measure with performance trends (scales used for comparison (versus goals, versus other service providers, versus a "maturity model," etc.)) (see at least page 28, last paragraph).*

**11. CLAIM 39:**

With regard to Claim 39, Mechling teaches *making recommendations to the organization on the basis of the comparing (conclusions and recommendations) (see at least page 39, paragraph 2 and Figure 6.).*

**12. CLAIM 40:**

With regard to Claim 40, Mechling teaches *wherein a cost-effectiveness measure is based on a ratio of at least one value of an outcome measure over a combination of annual expenditure and capital charge* (estimated benefit/cost (B/C) ratios) (see at least page 32, paragraph 1).

**13. CLAIM 41:**

With regard to Claim 41, Mechling teaches *excluding exogenous factors associated with an outcome measure* (ignore societal-level outcomes) (see at least page 22, first paragraph).

**14. CLAIM 42:**

With regard to Claim 42, Mechling does not teach *weighting at least one of the outcome measures relative to another outcome measure of the public sector organization*. Spears teaches *weighting at least one of the outcome measures relative to another outcome measure of the public sector organization* in analogous art of service improvement in the public sector for the purposes of, "Returns were weighted by gender, age and population of province..." (see at least page 10, paragraph 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit to yield normalized data for a more accurate group comparison (Spears, page 10, paragraph 7-page 11, third paragraph).

**15. CLAIM 43:**

With regard to Claim 43, Mechling does not teach *wherein the public sector organization includes at least one of: public health, revenue service, educational, police, courts, probation, fire, public transport, prisons, customs, immigration, postal services, regulatory bodies, public housing, defense, social security, customs, and public welfare*. Spears teaches *wherein the public sector organization includes at least one of: public health (hospitals), revenue service (Revenue Agency), educational, police (police), courts, probation, fire (fire departments), public transport, prisons, customs, immigration, postal services, regulatory bodies, public housing, defense (Coast Guard Search and Rescue), social security, customs, and public welfare* in analogous art of service improvement in the public sector for the purposes of, "Results show a broad range of access rating across all levels of government" (see at least page 25, paragraphs 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of having the broadest display of an analysis across all levels of government" (Spears, page 25, paragraphs 1-3).

**16. CLAIM 44:**

With regard to Claim 44, Mechling does not specifically teach *wherein, in the police organization, an outcome measure includes at least one of: public satisfaction with the police organization, reduction of crime, solving a crimes, and public served; and cost-effectiveness measure includes at least one of: reduction of variable cost, reduction of fixed cost, increase in asset efficiency*. Spears teaches *wherein, in the police organization, an outcome measure includes at least one of: public satisfaction with the police organization* (Police were very professional and did 'top notch' job!") (see at least page 20, in box "Citizens speak out") (2. Access, Access Access:) (see at least page 76), *reduction of crime, solving a crimes, and public served* in analogous art of service improvement in the public sector for the purposes of, "...to look at what their actual experience is and discover whether their concerns involve perception or reality" (see at least page 23, paragraph 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of an improved comparison of different organizations regarding public satisfaction (Spears, page 23, paragraph 3).

Mechling does not specifically teach *cost-effectiveness measure includes at least one of: reduction of variable cost, reduction of fixed cost, increase in asset efficiency*. Spears teaches *cost-effectiveness measure includes at least **one of**: reduction of variable cost, reduction of fixed cost, increase in asset efficiency* (2. Access, Access, Access:) in analogous art of service improvement in the public sector for the purposes of, "Streamline multiple channels into cost-effective, citizen-centered single gateways to service" (see at least page 76, under 2. Access, Access, Access:).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of the reduction of extra costs associated with obtaining a public service (Spears, page 76, under 2. Access, Access, Access:).

**17. CLAIM 45:**

With regard to Claim 45, Mechling does not specifically teach *wherein, in the public health organization, an outcome measure includes at least one of: improved health care, reduced errors in prescriptions*. Spears teaches *wherein, in the public health organization, an outcome measure includes at least one of: improved health care (Service quality (0-100), reduced errors in prescriptions* in analogous art of service improvement in the public sector for the purposes of, “Averaging across these services therefore gives a reasonable approximation of services “in general”” (see at least page 50, sentence 1 and Figure 26).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of a specialized comparison of different organizations regarding public satisfaction (Spears, page 50, sentence 1 and Figure 26).

Mechling does not specifically teach *cost-effectiveness measure includes at least one of: reduction of variable cost, reduction of fixed cost, increase in asset efficiency*. Spears teaches *cost-effectiveness measure includes at least **one of**: reduction of variable cost, reduction of fixed cost, increase in asset efficiency* (2. Access, Access, Access:) in analogous art of service improvement in the public sector for the purposes of, “Streamline multiple channels into cost-effective, citizen-centered single gateways to service” (see at least page 76, under 2. Access, Access, Access:).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of the reduction of extra costs associated with obtaining a public service (Spears, page 76, under 2. Access, Access, Access:).

**18. CLAIM 46:**

With regard to Claim 46, Mechling does not specifically teach *wherein, in the revenue service organization, an outcome measure includes at least one of: improved tax compliance, citizen satisfaction*. Spears teaches *wherein, in the revenue service organization (CCRA), an outcome measure includes at least **one of: improved tax compliance, citizen satisfaction*** (Timeliness, courtesy, extra smile) in analogous art of service improvement in the public sector for the purposes of, "This set of analyses shows that the five drivers do tend to recur across very different types of service (Figure 21)" (see at least page 41, last paragraph and Figure 21).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of a specialized comparison of different organizations regarding public satisfaction (Spears, page 50, sentence 1 and Figure 21 and Figure 26).

Mechling does not specifically teach *cost-effectiveness measure includes at least **one of: reduction of variable cost, reduction of fixed cost, increase in asset efficiency***. Spears teaches *cost-effectiveness measure includes at least **one of: reduction of variable cost, reduction of fixed cost, increase in asset efficiency*** in analogous art of service improvement in the public sector for the purposes of, "Streamline multiple channels into cost-effective, citizen-centered single gateways to service" (see at least page 76, under 2. Access, Access, Access:).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of the reduction of extra costs associated with obtaining a public service (Spears, page 76, under 2. Access, Access, Access:).

**19. CLAIM 47:**

With regard to Claim 47, Mechling does not specifically teach *providing a recommendation to the public sector organization that includes at least one proposed solution to improve the relative performance measure of the public sector organization*. Spears teaches *providing a recommendation to the public sector organization that includes at least one proposed solution to improve the relative performance measure of the public sector organization* in analogous art of service improvement in the public sector for the purposes of, “suggested several additional solutions to problems with accessing services via telephone (Figure 17)” (see at least page 34, last paragraph and Figures 16 and 17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of an improved recommendation based on the analysis of the performance measures (Spears, page 34, last paragraph and Figures 16 and 17).

**20. CLAIM 48:**

With regard to Claim 48, Mechling teaches *providing a recommendation to the public sector organization that includes at least one consulting service to improve the relative performance measure of the public sector organization (...with the help of a private consortium lead by Deloitte Consulting and NIC,...)* (see at least page 5, first paragraph).

**21. CLAIM 49:**

With regard to Claim 49, Mechling teaches *wherein determining a relative performance measure includes evaluating the performance of the public sector organization as a function of time* (developed the Common Measurements Tool (CMT) as a vehicle to bring consistency to client satisfaction measurement across time and between organizations) (see at least page 23, first paragraph).

**22. CLAIM 50:**

With regard to Claim 50, Mechling teaches *deriving a proposed solution for improving the relative performance measure on the basis of evaluating the performance of the public sector organization as a function of time* (suggested that replacing the Department of Transportation's call center with a web-based system could save taxpayers more than \$240, 000 per year) (see at least page 24, first paragraph).

**23. CLAIM 51:**

With regard to Claim 51, Mechling does not specifically teach *wherein determining a relative performance measure includes evaluating the performance of the public sector organization by comparing one public sector organization having one relative performance measure to another public sector organization having another relative performance measure*. Spears teaches *wherein determining a relative performance measure includes evaluating the performance of the public sector organization by comparing one public sector organization having one relative performance measure to another public sector organization having another relative performance measure* in analogous art of service improvement in the public sector for the purposes of, "Since the results compare different services at each level,...", and, "...they may simply reflect a set of services at one level that are inherently easier to access than the sets at other levels" (see at least page 31, last paragraph through page 32 and Figure 13).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of a broader yield of a normalized analysis of comparison between the different public sector organizations (Spears, page 31, last paragraph through page 32 and Figure 13).

**24. CLAIM 52:**

With regard to Claim 52, Mechling does not specifically teach *deriving a proposed solution for improving a relative performance measure on the basis of comparing one public sector organization having one relative performance measure to another public sector organization having another relative performance measure*. Spears teaches *deriving a proposed solution for improving a relative performance measure on the basis of comparing one public sector organization having one relative performance measure to another public sector organization having another relative performance measure* in analogous art of service improvement in the public sector for the purposes of, "Solutions to some of the problems are quite clear. If a phone line is overly busy, for example, it indicates a need for more operators..." (see at least page 34, last paragraph and Figures 15-17).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit of an increased awareness to have a suggestion or solution to improve the performance measure (Spears, page 34, last paragraph and Figures 15-17).

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**25. CLAIM 53:**

With regard to Claim 53, Mechling does not specifically teach *using the relative performance measure to perform a correlation analysis between the relative performance measure and a particular outcome measure or a particular cost-effectiveness measure*. Spears teaches *using the relative performance measure to perform a correlation analysis between the relative performance measure and a particular outcome measure or a particular cost-effectiveness measure* in analogous art of service improvement in the public sector for the purposes of, “The correlation between these variables is near zero” (see at least page 25, paragraph 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the weighting feature taught by Spears with the electronic service deliver (ESD) method as taught by Mechling. One of ordinary skill in the art would have been motivated to do so for the benefit to have a more defined benefit vs. cost correlation and comparison between the different public sector organizations (Spears, page 25, paragraph 6).

**26. CLAIMS 1-34:**

With regard to Claims 1-34, Claims 1-19 and Claims 20-34 recite *system* and *computer program product* limitations, respectively. Although Mechling and Spears do not specifically teach a *system* and *computer program product*, Official Notice is taken that to automate methods are old and well known measures in the art at the time of the invention.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine a computer system and computer program product with the teachings of Mechling in view of Spears.

***Conclusion***

**27.** The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Lingwood et al (U.S. Pub. No. 2003/0033233) discloses evaluating an organization's level of self-reporting.
- Case (U.S. 6,859,785) discloses a diagnostic method and apparatus for business growth strategy.
- Brignall et al, "An institutional perspective on performance measurement and management in the 'new public sector'", Management Accounting Research, 2000, 11, 281-306, discloses the implications of institutional theory for the successful implementation of multidimensional performance measurement and management in the public sector.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS MANSFIELD whose telephone number is (571)270-1904. The examiner can normally be reached on Monday-Thursday 8:30 am-6 pm, alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. M./  
Examiner, Art Unit 3623

12 February 2008  
Thomas Mansfield

/Beth Van Doren/  
Primary Examiner, Art Unit 3623